

REMARKS

Claims 1-10 are pending and have been examined in the present application.

Claims 1 and 2 stand rejected under 35 U.S.C. §§102(a) or (e) as being anticipated by U.S. Patent No. 6,908,872 to Tanaka et al. Applicants respectfully traverse this rejection.

Although Tanaka et al. discloses a composition having a range overlapping the claimed range, it is respectfully submitted that Tanaka et al. does not anticipate the present invention as defined in independent claim 1 because Tanaka et al. does not disclose the claimed range with "sufficient specificity."

MPEP §2131.03 provides that when the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation.

In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. The question of "sufficient specificity" is similar to that of "clearly envisaging" a species from a generic teaching. MPEP §2131.03.

The claimed molar ratio ranges of x, y and z in independent claim 1 are narrower and only slightly overlap the broader molar ratio ranges disclosed in Fig. 1 of Tanaka et al. In addition, none of the tables of Tanaka et al. disclose a composition that falls within the range defined in independent claim 1. There is an important reason why this is so.

The ceramic composition disclosed in Tanaka et al. is specifically formulated to provide a transparent ceramic for use in optical lens applications. See col. 1, line 39 to col. 2, line 33. The ceramic composition of Tanaka et al. is not designed for high-frequency applications or to address any of the problems associated therewith. In contrast, the present invention provides a dielectric ceramic for use in high-frequency applications which has the unexpected results of providing a large relative dielectric constant together with a high Q-factor. See page 2, line 14 to page 3, line 26 of the present specification.

Therefore, it is respectfully submitted that the molar ratios defined in independent claim 1 are not disclosed in Tanaka et al. with sufficient specificity to constitute an anticipation under the statute. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as being anticipated by EP0838446. Applicants respectfully traverse this rejection.

Applicants wish to point out that examples 40-48 of EP0838446 relied upon in the Office Action disclose a dielectric material in terms of weight percent (wt.%), and not molar ratio as required by independent claim 1. Specifically, the corresponding

molar ratio of Sn in EP0838446 is significantly less than the molar ratio required by independent claim 1. Thus, EP0838446 can not anticipate claim 1, and reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as being anticipated by JP6-74162. Claims 3-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP6-74162 in view of U.S. Patent No. 6,369,669 to Tatekawa et al. Applicants respectfully traverse these rejections.

Applicants wish to point out that the molar ratios of Sn disclosed in JP6-74162 are less than the molar ratio for Sn required by independent claim 1. Thus, JP6-74162 can not anticipate claim 1.

Tatekawa et al. does not remedy any of the deficiencies of JP6-74162. There is nothing within Tatekawa et al. which teaches or even remotely suggests the molar ratios required by independent claim 1. Therefore, even if one were to combine the teachings of Tatekawa et al. and JP6-74162, one would not arrive at the present invention.

Accordingly, reconsideration and withdrawal of the above rejections is respectfully requested.

Moreover, Claims 2-10 depend either directly or indirectly from independent claim 1 and include all of the limitations found therein. Each of these dependent claims include additional limitations which, in combination with the limitations of the claims from which they depend, are neither disclosed nor suggested in the art of record. Accordingly, claims 2-10 are likewise patentable.

In view of the foregoing, favorable consideration and allowance of the present application with claims 1-10 is respectfully and earnestly solicited.

Dated: November 7, 2005

Respectfully submitted,

By Richard LaCava

Richard LaCava

Registration No.: 41,135

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant